

**REMARKS**

Claims 1-37 are pending in this application. Claim 36 is herewith canceled as being directed to non-elected subject matter. Thus, with the entry of this amendment, claims 1-35 and 37 will be active in this case.

**I. Formalities**

The Examiner has requested applicants to amend the specification to add the lineage of this application. In response, applicants have made the requested amendment.

**II. Rejection under 35 USC § 112****A. Enablement**

The Examiner rejects claims 1-35 and 37 under 35 USC § 112 for allegedly failing to meet the enablement requirement for the asserted reason that "the only use contemplated for the epitope-tagged TBP-containing transcription complexes and the specification does not offer any guidance for preparing a transgenic animal that expresses the epitope-tagged TBP at a level sufficient to allow for the isolation of TBP-containing complexes." Action at page 3, last paragraph.

Applicants interpret this as meaning that a showing that applicants have transgenically produced sufficient levels of TBP-containing complexes to isolate and purify them by standard means would overcome this rejection. Applicants assert that they already have demonstrated such levels with the declaration of Dr. Kirschbaum filed March 15, 2002. Applicants further understand, however, that the Examiner did not have the figures that accompanied the declaration. Applicants attach another copy of these figures for the Examiner's consideration. Applicants also understand that the Examiner did not receive a copy of the Berglund thesis. Applicants will supplement this response with a copy of the Berglund thesis.

**B. Indefiniteness**

The Examiner has rejected claims 7-10 under 35 USC § 112, second paragraph, for reciting "transferring said transfected germline cells to a surrogate mother, and permitting said germline cell to develop into a non-human transgenic animal." Action at page 8, last paragraph. The Examiner also questions the transfer of a transgene into an embryonic stem cell in claim 10 and the blastomere of claim 9. In response, applicants herewith amend these claims to clarify the invention. Support for the amendments can be found at page 15, final paragraph to page 18, first paragraph. Withdrawal of this rejection is requested in view of this amendment.


**Conclusion**

Applicants respectfully request entry of the above amendment and consideration of the comments. Applicants will supplement this response with a copy of the missing Berglund thesis.

Future correspondence in this case should be directed to the address associated with Customer Number 005487, as indicated on that attached Revocation of Power of Attorney and New Power of Attorney.

Respectfully submitted,

Date: June 4, 2004  
**Heller Ehrman White & McAuliffe LLP**  
1666 K Street, N.W., Suite 300  
Washington, D.C. 20006-4004  
Telephone: (202) 912-2000  
Facsimile: (202) 912-2020

  
Patricia D. Granados  
Attorney for Applicant  
Reg. No.: 33,683

**Customer No. 26633**